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REMARKS

Counsel for applicants appreciates the courtesy of the interview on 21 September 2006.

The following incorporates a summary of the interview.

The applicants acknowledge receipt of the initialed copy of the forms PTO-1449 which have been filed. Please note that a Form PTO-1449 was filed on 16 August 2006.

Claims 1-4, 6-10, 13-18, and 20-54 are pending. Claims 5, 11-12, and 19 have been canceled. Claims 29-53 have been withdrawn. The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 18 and 25 were objected to as including the language "an intellectual property environment." Claims 18 and 25 have been amended to remove the language. The examiner is therefore respectfully requested to reconsider and withdraw the objection.

Also, claims 9, 10, 17 and 21 have been amended for clarity. Claims 4, 6, and 20 have been amended to conform to the amendments to the independent claim from which they depend. Further support for amended claims 6 and 20 is located in the specification, for example, page 49, line 12 and page 37, line 3.

Claims 1-28 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent No. 6,877,137, Rivette et al. ("Rivette"). The claims have been amended, including independent claims 1, 18 and 25. Support for amended claims 1, 18 and 25 is located in original claim 3, FIG. 1, FIG. 12-FIG. 14, page 24 lines 13-18, page 32 lines 16-22, and page 44 line 13 to page 47 line 2. Support for amended claim 2 is located in page 31, lines 7-12 and FIG. 10. Support for amended claim 3 is located in FIG. 5 and FIG. 6 and corresponding description on pages 29 and 30. Support for amended claim 7 is located in FIG. 11 and FIG. 15, and page 43, line 20 to page

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44, line 7. Support for amended claim 13 is located in FIG. 14 and page 49, line 13 to page 50, line 10. Support for amended claims 16, 24, and 26 is located in FIG. 7 and FIG. 8, and page 30, line 19 to page 31, line 17.

Insofar as the rejection may be applied to the claims as amended, the rejection is respectfully traversed for reasons including the following, which are provided by way of example.

The specification recognizes the need for methods and computer systems that allow the ability to mark up an electronic representation of a document, edit the document, and note relations between documents. (Specification, page 3, lines 16-20.)

Independent claim 1 is directed to "a computer-implemented system for providing annotated electronic documents, the annotations which are to be applied to the documents being stored in a first data storage, the documents being stored in a second data storage, the first data storage and the second data storage being at least one of physically separate and logically separate." Independent claim 1 recites in combination, for example, "at least one merge component configured: to retrieve the at least one document from the first data storage as document data, to retrieve the at least one annotation to be applied to said at least one document from a second data storage as annotation data, and to combine the annotation data and the document data to form a single logical document, the single logical document having the annotation data embedded in the document data." (See also independent claim 18 and 25.)

Furthermore, independent claim 18 also recites, in combination, "at least one split component configured: to extract the annotation data and the document data from the single logical document, to update the at least one annotation in the first data storage from the extracted

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annotation data, and to update the at least one document in the second data storage from the extracted document data.” (See also dependent claim 7.)

Thereby, even though it may be undesirable to have users marking-up and physically embedding information into the same document, the system can seamlessly associate mark-up data (annotations) with document information, and the marked-up document can be treated as a single, unitary document. In addition, despite the unitary appearance, when the user is finished working on the document, the document and mark-up information can be broken out and stored separately. (E.g., page 32, lines 3-14.)

On the other hand, without conceding that Rivette discloses any feature of the present invention, Rivette is directed to a system and method of manipulating notes linked to web pages (Abstract). According to Rivette, a web annotation system (502) includes a notes engine(506), a web pages engine (509) a notes database (508) and a web pages database (509). The notes database (508) includes annotations that are attached to web pages. The web pages database (509) optionally can cache web pages. (Col. 11, lines 40 to Col. 12, line 7).

To properly reject a claimed invention, the examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, the teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The

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examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The applicants provide herein a selection of some examples of limitations in the amended claims which are neither taught nor suggested by Rivette. The Office Action contends that Rivette teaches each recited element, or “can be reasonably interpreted” as teaching certain elements, or that it would have been obvious to modify certain elements of Rivette. However, Rivette fails to teach or suggest each recited limitation in the amended claims.

For example, Rivette never combines the annotation data and the web page into a single document. Rather, annotation data and document data are handled separately. Rivette more fully explains the notes database 508 and the relationship between notes and portions of web pages in connection with FIG. 30. The notes and web pages are linked by bookmark links. (Col. 30, lines 22-50.) Further according to Rivette, the computer display (1202) includes a Web page window (1208) displaying the document, a notes toolbox window (1206), a notes/Web page directory window (1212) and a notes text window (1214). (Col. 21, lines 19-50.) In operation, “in step 3512, the notes engine 506 commands the application associated with the Web page to display a linking button proximate or adjacent to the selected portion” (Col. 34, lines 7-12) (also see FIG. 11 for symbols used as linking buttons). It should be noted that the “linking button” is not the annotation data or the document data. Consequently, Rivette fails to teach or suggest the at least one merge component that combines the annotation data and the document data. Moreover, Rivette fails to teach or suggest that the annotation data and the document data can be combined to form a single logical document with the annotation data embedded in the document data.

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Insofar as the office action can be applied to the claims as amended, the office action argues that groupings of notes linked to portions of a target web page teach a merge component configured to combine annotation data and document data to form a single logical document with the annotation data embedded in the document data. The office action contends that Rivette teaches a merge component at Col. 13, lines 5-10. To the contrary, Rivette fails to teach or suggest the merge component as recited. Rivette's "note grouping table" stored separately from a web page fails to teach or suggest that the annotation data and document data are combined to form a single document, and further fails to teach or suggest that the single document has the annotation data embedded in the document data.

Also, the office action argues that Rivette "can be reasonably interprets [sic] as 'split component,'" (see claims 7 and 18) since Rivette allegedly teaches an annotation linked to a selected portion of a web page. To the contrary, Rivette fails to teach or suggest that the annotation data and document data can be extracted from the single logical document, where the single logical document has the annotation data embedded in the document data. Because Rivette fails to teach or suggest the single document with annotation data and document data, nothing in Rivette provides for extraction of the annotation data and document data from the single document.

Moreover, Rivette fails to teach or suggest that the document (i.e., the cited web page) is updated from the extracted document data. To the contrary, Rivette's stored web pages are not updated.

Rivette simply operates in a fundamentally different way than the claimed invention. Specifically, Rivette does not teach or even suggest, let alone disclose, anything about combining the annotations and the document data to form a single document. Similarly, Rivette does not

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teach or even suggest anything about extracting the annotation data and document data from a single document. The Office Action cites Rivette as disclosing this limitation. However, because Rivette is concerned with annotating web pages, Rivette is clearly deficient considering the invention as claimed as a whole. Consequently, the proposed modification of Rivette fails to teach or suggest the claimed invention.

Hence, Rivette, even if modified as proposed in the office action, fails to teach or suggest the combination of features recited in independent claims 1, 18 and 25 when considered as a whole.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 1, 18, and 25, but also because of additional features they recite in combination. Examples are provided below.

Claim 2 recites in combination a “view component ... to edit ... the at least one portion of the at least one document selected by the selection resource.” The examiner cites Rivette’s web page as equivalent to the “at least one document.” Rivette, to the contrary, fails to teach or suggest editing the web page.

Claim 3 recites in combination that the merge component is configured to “display the single logical document as a representation of the at least one document,” where the logical document includes the annotation data and the document data. To the contrary, Rivette provides for separate displays of the annotations and the web page.

Claim 9 recites in combination a version component that manages a history of changes and maintains separate version “for the at least one document and the at least one annotation applied thereto.” The examiner cites Rivette’s web page as equivalent to the “at least one

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document." Rivette, to the contrary, fails to teach or suggest editing the web page, and hence fails to teach or suggest managing a history of changes for the web page.

Claim 16 recites both a report component and a map component. Rivette fails to provide the report component listing each annotation and in visual correspondence thereto a summary of each portion of the document associated with each annotation. Rivette fails to teach or suggest a summary of the portions of the documents that are annotated. In addition, Rivette fails to provide a map component listing a summary of each portion in the document, each annotation in the document, and each reference from the document, where the annotations and references are visually linked to the portion listed in the summary. Rivette further fails to teach or suggest the visual link.

The arguments with regard to claim 16 apply equally to claim 26.

Claim 24 recites a report tool and a map tool. Rivette fails to teach or suggest a report tool as recited, or a map tool as recited, to provide a report from the single logical document with a summary of the elements.

New claim 54 corresponds to original claims 24, portions (E), (F) and (G), with revisions for clarity and to correspond to amended claim 18 from which it depends. No new matter has been added. New claim 54 is believed to be patentable for reasons including these set out above.

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

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Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,



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